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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,812	03/30/2001	David W. Cannell	05725.0783-00	5365

22852 7590 07/28/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER	
WANG, SHENGJUN	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/820,812	CANNELL ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-100* is/are pending in the application.

4a) Of the above claim(s) *7-16,18,20,21,34-42,55-69 and 82-90* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,17,19,22-33,43-54,65,70-81,91-100* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted May 10, 2004 is acknowledged.

Double Patenting Rejections

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44-146 of U.S. Patent No. 6,486,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims herein are generic to the claims presented in '105.

Claims Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karlen et al (US Pat. 6,004,545) in view of Bertho et al (US Pat. 5,688,930) or Bertho et al (US Pat. 6,087,403).

Karlen teaches a hair cleansing composition with fixing properties. Karlen teaches the compositions can contain amphoteric film-forming polymers (see col. 7, lines 4-15), specifically teaching that suitable amphoteric polymers for use in the compositions include AMPHOMER LV-71 (see col. 8, lines 1-16). The composition necessarily include a surfactant chosen from a group that includes nonionic surfactants (see col. 2, lines 6-20). Karlen teaches that suitable nonionic surfactants such as alkylpolyglucosides are particularly preferred (see col. 4, lines 23-39).

Karlen does not teach expressly the employment of a mixture of hexadecyl and octadecyl glycosides associated with a heating step.

However, Bertho (6930) teaches mixtures of alkyl glycosides from wheat by-products, such as wheat straw (see abstract). The mixtures are useful as surfactants, including hair care applications (see col. 6, lines 1 1-35, especially line 21). The mixture of glycosides includes glucose, xylose, and arabinose (see col. 2, Lines 35-45). Xylose is inherently present in the mixtures. The alkyl groups taught by Bertho range from 6-22 carbon atoms, particularly 14-20 carbon atoms (see col. 3, Lines 53-67*, and col. 7, Lines 6-9). The mixtures are included at 0.1-60% by weight in order to give surface-active properties to a composition (see col. 7, Lines 13-18). The surfactants taught by Bertho come from cheap raw material and have economic advantages over alkylpolyglucosides (see col. 1, Lines 35-53). Bertho (.403) teaches emulsifying compositions based on fatty alcohols and polyglycoside mixtures (see col. 2, lines 52-67, col. 3,

lines 1-40, and col. 5, lines 16-25). The compositions are used as emulsifiers (see col. 6, Lines 31-43, and col. 7, lines 18-25). Bertho teaches that the compositions are advantageously cheaper than those based on purified glucose (see col. 5, lines 39-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hair compositions of Karlen by the use of alkylglycoside mixtures disclosed by Bertho instead of alkylpolyglucosides in order to benefit from the emulsifying properties of the polyglycosides or economic advantages as taught by Bertho ('930) or Bertho ('403). Further, drying hair by heating followed the employment of hair-care composition is a common practice. As to the limitation "protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage," note when people use the hair care products as suggested by the prior art, the recited function would be inherently realized.

Response to the Arguments

Applicants' remarks submitted May 10, 2004 have been fully considered, but are not persuasive for reasons discussed below.

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Particularly, applicants argue that since Karlen does not teach a specific combination of Amphomer LV-71 and alkylpolyglucoside, the rejection based on Karlen is improper. The examiner disagrees. Note, question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. In instant situation, Karlen teaches the usefulness of alkylpolyglucoside in the cosmetic composition comprising Amphomer LV-71. Karlen particularly suggest the preference of the alkylpolyglucoside as the surfactant in the composition. Therefore, at the time the claimed invention was made, one of ordinary skill in the art would have been motivated to make the Amphomer LV-71 containing composition by incorporating an alkylpolyglucoside.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion or motivation are found both in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Bertho teaches the usefulness of the alkyl glycosides as surfactants in cosmetic compositions. Bertho further teaches the advantage of the alkyl glycosides over other surfactants known in the art. Those teachings provide one of ordinary skill in the art sufficient motivation to combine.

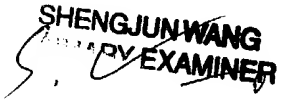
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



Shengjun Wang

July 23, 2004